

Remarks

I. Status of the claims

Claims 1-3, 6, and 8-10 are pending. Claim 1 has been amended to recite that the polyol is present in the emulsion in an amount ranging from 20 to 60 wt.%. Support can be found in the Specification at least at page 11, lines 9-12. Accordingly, no new matter has been introduced by this Amendment.

II. Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claims 1-3, 6 and 8-10 as failing to comply with the written description requirement and introducing new matter into the patent application. Applicants have amended claim 1 to recite that the polyol is present in the emulsion in an amount ranging from 20 to 60 wt.%. Support can clearly be found in the Specification at least at page 11, lines 9-12. Accordingly, Applicants request withdrawal of this rejection.

III. Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 1-3, 6 and 8-10 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,013,682 (“Dalle et al.”) in view of U.S. Patent No. 5,443,760 (“Kasprzak”). Applicants respectfully traverse this rejection.

As amended, the claimed invention relates to a transparent sprayable oil-in-water emulsion comprising from about 5 to about 15% w/w of an oily component; from about 85 to about 95% w/w of an aqueous phase; and from about 0.05 to about 10% w/w of an emulsifier. The oily component comprises from 5 – 12 % of one or more silicone waxes; from 0.5 – 2.5 % of one or more silicone oils; and optionally one or more suitable oils. The aqueous phase comprises one or more polyols selected from ethylene glycol, propylene glycol, butylene glycol, pentylene glycol, hexylene glycol, glycerine, sorbitol, cyclohexanediol and mixtures thereof. The emulsifier is selected from an ethoxylated or propoxylated fatty alcohol. The viscosity of the emulsion is less than 100mPas measured with a plate/cone rotation rheometer at a constant shear rate of 500 s⁻¹. The polyol is present

in the emulsion in an amount ranging from 20 to 60% w/w and is effective to adjust the refractive index of the aqueous phase so that it does not differ more than about 0.003 from the refractive index of the oily component. As discussed in the Specification, through the use of the oil-in-water emulsion having the components recited by the present claims, Applicants discovered that a transparent, sprayable cosmetic oil-in-water formulation that provides good miniaturization could be obtained. Such a cosmetic formulation is neither taught nor suggested by the prior art relied upon by the Examiner.

Dalle et al. relates to silicone in water emulsions comprising at least one polysiloxane, at least one organosilicone material that reacts with the polysiloxane by a chain extension reaction and a metal catalyst for the reaction; (II) at least one surfactant; and (III) water. There is no teaching or suggestion of the transparent sprayable oil-in-water emulsion recited by the present claims. In particular, there is no teaching or suggestion of an emulsifier selected from an ethoxylated or propoxylated fatty alcohol or the polyol recited by the present claims, much less, of a sprayable transparent oil-in-water emulsion wherein the refractive index of the aqueous phase does not differ more than about 0.003 from the refractive index of the oil phase.

The Examiner argues that because Dalle et al. teaches the inclusion of nonionic surfactants Dalle et al. teaches a polyol. At page 7 of the office action the Examiner states “Dalle et al teach that polyols can be present in an amount of 1-30 wt.%" However, Applicants were unable to find anywhere in Dalle et al. of such a teaching. The nonionic surfactants recited by Dalle et al. are not the same as the polyols recited by the present claims and there is clearly no teaching or suggestion that a polyol should or could be included to adjust the refractive index of the aqueous phase.

The Examiner relies upon Kasprzak as teaching the inclusion of silicone oils in oil-in-water emulsions. According to the Examiner, because Kasprzak teaches the inclusion of silicone oils it would have been obvious to include silicone oils in the emulsions taught by Dalle et al. The Examiner argues that one would be motivated to do so “because the combined ingredients of silicone wax and silicone oils as the oily component of the oil-in-water emulsion would result in a complementary or possibly synergistic effect.” Applicants again request clarification of this supposed teaching of “a complementary or possibly synergistic effect.” The Examiner simply states that it is “prima facie obvious to combine two compositions useful for the same purpose in order to form a third composition to be used for the same purpose.”

However, even if one of ordinary skill in the art were somehow motivated to incorporate the silicone oils, one of ordinary skill would not arrive at the presently claimed invention. There is no teaching or suggestion in Dalle et al. or Kasprzak of an emulsifier selected from an ethoxylated or propoxylated fatty alcohol or of the inclusion of from 20 to 60% w/w polyol wherein the polyol is effective to adjust the refractive index of the aqueous phase so that it does not differ more than about 0.003 from the refractive index of the oily component.

The Examiner argues that Kasprzak teaches the inclusion of humectants such as hexylene glycol, propylene glycol and glycerine which are included as polyols in the instant claims. However, there is no teaching or suggestion that hexylene glycol, propylene glycol or glycerine should be present in amounts useful to adjust the refractive index of an aqueous phase, i.e., from 20 to 60 wt.%. In fact, the only teaching by Kasprzak of suitable amounts of humectant is in the Examples which are limited to the use of propylene glycol at 8 weight %, well outside the range of polyol recited by the present claims.

Further, Kasprzak fails to cure the deficiencies of Dalle et al. discussed above. There is no teaching or suggestion of the transparent, sprayable oil-in-water emulsion having the properties recited by the present claims. The Examiner argues that the “combination of Dalle and Kasprzak teaches the obvious emulsion of the instant claims” and that “the instant limitations” “would be obvious expected properties of the composition.” Applicants respectfully disagree. For the reasons discussed above, the combination of Dalle et al. and Kasprzak does not render the presently claimed emulsions obvious. Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding objections and rejections. If the Examiner feels that a discussion with Applicants' representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/J&J5012USPCT/JPB. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 10-0750/J&J5012USPCT/JPB.

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